

This Opinion is Not a  
Precedent of the TTAB

Mailed: August 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Sporting Soles, Inc.*  
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Serial No. 87892535  
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Terrence J. Edwards of TechLaw Ventures PLLC,  
for Sporting Soles, Inc.

Teague Avent, Trademark Examining Attorney, Law Office 125,  
Heather Biddulph, Managing Attorney.

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Before Zervas, Kuczma, and English,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Sporting Soles, Inc. (“Applicant”) seeks registration on the Principal Register of  
the mark SPORTING SOLES, in standard characters, for:

Retail sporting goods stores; on-line retail sporting goods stores; retail store services featuring a wide variety of consumer goods of others and on-line retail store services featuring a wide variety of consumer goods, namely, sporting goods; retail store services and on-line retail store services featuring clothing and apparel, footwear and sports accessories, and headwear; retail stores featuring running shoes, sports shoes, running and sports clothing and apparel, sports accessories, namely, foot care products, muscle care products, injury aid products, hydration gear and products, sports nutrition products, reflective products, light safety products, sports watches, sunglasses,

pedometers, speed and cadence sensors, sensors for providing information relating to distance, time, pace and calories burned, heart rate monitors for sports activities, smartphone carriers, running belts for carrying fluids and sports equipment; on-line retail store services featuring running shoes, sports shoes, sports clothing, sports accessories, namely, foot care products, muscle care products, injury aid products, hydration gear and products, sports nutrition products, reflective products, light safety products, sports watches, sunglasses, pedometers, speed and cadence sensors, sensors for providing information relating to distance, time, pace and calories burned, heart rate monitors for sports activities, smartphone carriers, running belts for carrying fluids and sports equipment in International Class 35.<sup>1</sup>

The Trademark Examining Attorney refused registration on the ground that Applicant's applied-for mark is merely descriptive of the identified services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. The appeal is fully briefed.<sup>2</sup> We affirm the refusal to register.

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<sup>1</sup> Application Serial No. 87892535; filed April 25, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's claim of a bona fide intent to use the mark in commerce.

Citations to the prosecution record are to the Trademark Status & Document Retrieval ("TSDR") system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVue, the Board's online docketing system.

<sup>2</sup> The Board issued an order on May 11, 2020 refusing consideration of Applicant's reply brief on the ground that it exceeds the 10-page limit. 16 TTABVue. The text of Applicant's reply brief, however, is 8 pages so we have considered it. We have not, however, considered the third-party registrations attached to Applicant's reply brief for the reason explained in footnote 16 *infra*.

## I. Record on Appeal<sup>3</sup>

The Examining Attorney made the following evidence of record:

- MERRIAM-WEBSTER online dictionary definitions for the words “sporting” and “sole”;<sup>4</sup>
- Wikipedia entry for “sneakers”;<sup>5</sup>
- Internet articles and social media posts regarding sports shoes and soles for sports shoes;<sup>6</sup>
- Results of a search for “discount sporting shoes” on DHGate.com;<sup>7</sup>
- Results of searches on Amazon.com for “sporting shoes,” “sports soles,” and “sole sport insoles”;<sup>8</sup>
- Screenshot of an online auction for “sporting shoes” on HiBid.com;<sup>9</sup>
- Screenshot of a shoe insole for sale on solesportsrunning.com;<sup>10</sup> and
- Screenshots of shoe insoles for sale on dickssportinggoods.com.<sup>11</sup>

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<sup>3</sup> Both the Examining Attorney and Applicant submitted multiple copies of the same evidence. This is neither a courtesy nor a convenience to the Board. Multiples copies of the same evidence can cause confusion in reviewing the record and unnecessary delay in issuing a final decision. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at \*1 (TTAB 2019).

<sup>4</sup> August 23, 2018 Office Action at TSDR 5-18.

<sup>5</sup> April 2, 2019 Final Office Action at TSDR 6-9.

<sup>6</sup> *Id.* at 10-37 and 45-49.

<sup>7</sup> *Id.* at 50-56.

<sup>8</sup> *Id.* at 38-42 and 58-65; October 22, 2019 Denial of Request for Reconsideration at TSDR 6-13.

<sup>9</sup> April 2, 2019 Final Office Action at TSDR 43.

<sup>10</sup> October 22, 2019 Denial of Request for Reconsideration at TSDR 4.

<sup>11</sup> *Id.* at 43-47.

Applicant submitted the following evidence that is of record for this appeal:<sup>12</sup>

- MERRIAM-WEBSTER online dictionary definition for the word “soul”;<sup>13</sup>
- An article from the website Lifehack.org titled “15 Tell-Tale Signs You’re an Old Soul and Think Differently”;<sup>14</sup> and
- An article from the website writingexplained.org explaining the differences between the words “sole” and “soul.”<sup>15</sup>

Applicant also embedded in its appeal brief a list of third-party registered marks. The Examining Attorney has objected to this evidence as untimely. We agree. The record in the application should be complete before an appeal is filed, and evidence submitted for the first time with a brief is untimely. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1203.02(e) and 1207.01 (2020). Accordingly, the Examining Attorney’s objection is sustained. We have not considered the third-party registrations listed in Applicant’s brief.<sup>16</sup>

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<sup>12</sup> Applicant’s Internet evidence is missing the required URL addresses and/or dates the pages were printed. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018). The Examining Attorney, however, did not object to Applicant’s evidence on this basis. Accordingly, we deem any such objection waived and have considered Applicant’s Internet evidence.

<sup>13</sup> February 25, 2019 Office Action Response at TSDR 8-9.

<sup>14</sup> *Id.* at 10-13.

<sup>15</sup> October 2, 2019 Request for Reconsideration at TSDR 11-14.

<sup>16</sup> For this same reason, we have not considered the third-party registrations that Applicant attached to its reply brief. *Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (refusing consideration of “the manifestly untimely submissions included with [applicant’s] reply brief”).

## II. Decision

### A. Applicable Law

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a mark which, when used on or in connection with an applicant's goods or services, is merely descriptive of them.<sup>17</sup> A term is merely descriptive of goods or services if it conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018).

Whether a term is merely descriptive is not determined in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the term is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner in which the term is used or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Canine Caviar Pet Foods*, 126 USPQ2d at 1598. The question is whether someone who knows the goods or services will understand the term to convey

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<sup>17</sup> Applicant's application is based on an intent to use the applied-for mark. Accordingly, Applicant has not claimed acquired distinctiveness in an attempt to overcome the refusal.

information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *See, e.g., id.* (SNAP SIMPLY SAFER merely descriptive of “medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration, and injection syringes”); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012) (holding SEMICONDUCTOR LIGHT MATRIX merely descriptive of light and UV curing systems composed primarily of light-emitting diodes for industrial and commercial applications); *In re Petroglyph Games Inc.*, 91 USPQ2d at 1341-42 (finding BATTLECAM for computer game software merely descriptive “because the combination of the terms does not result in a composite that alters the meaning of either of the elements”).

## **B. Arguments**

The Examining Attorney argues that: (1) “SPORTING is merely descriptive of a feature of applicant’s retail store services featuring sporting goods and retail sporting store services, because applicant’s stores feature goods to be used for sports”; (2) “SOLES is merely descriptive of a feature of applicant’s retail sporting goods stores and retail store services,” because “foot care products” in the identification of services

encompass soles for shoes and the evidence demonstrates that “soles” are a type of sporting good; and (3) when combined in Applicant’s mark, the terms retain their descriptive significance “merely indicat[ing] that applicant’s sporting goods stores offer for sale footwear products, namely, soles or shoes with soles that are used for sports.”<sup>18</sup> The Examining Attorney further asserts that “[t]he evidence of record ... showing third parties using the term ‘sporting shoes’ to identify shoes for use in sports indicates that ... consumers are familiar with the term ‘sporting shoes’ and would understand that ‘sporting soles’ similarly refers to soles suitable for sports.”<sup>19</sup>

Applicant counters that its mark is a double entendre comprising a “fanciful play on the phonetically identical terms ‘sole’ and ‘soul’ ... suggest[ing] that a person with a ‘sporting soul,’ or a person who loves sports or considers sporting to be part of his ‘soul’ would be interested in Applicant’s services.”<sup>20</sup> Applicant explains: “Similar to the phrase ‘old souls,’ Applicant’s selection of the applied-for mark SPORTING SOLES is intended to generate an appeal between its services and consumers that have sports as part of their soul.”<sup>21</sup>

Alternatively, Applicant asserts that its proposed mark “is an incongruity because [there is no evidence of] the terms ‘sporting’ and ‘soles’ being used together or having

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<sup>18</sup> Examining Attorney’s Brief, 14 TTABVUE 6-10.

<sup>19</sup> *Id.* at 10.

<sup>20</sup> Applicant’s Brief, 12 TTABVUE 5.

<sup>21</sup> *Id.* at 8.

an accepted meaning when used together”<sup>22</sup> and because “[t]he idea of ‘soles’ being ‘sporting’ is too strange to merely describe applicant’s services.”<sup>23</sup>

### C. Analysis

There is no dispute that the word “sporting,” defined as “of, or related to, used or suitable for sport,”<sup>24</sup> is descriptive of Applicant’s retail and on-line retail sporting goods stores.

We find that the word “soles” also is descriptive for Applicant’s services. The term “sole” is defined as, among other things, “the bottom of a shoe, slipper or boot”; “the part of an item of footwear on which the sole rests and upon which the wearer treads.”<sup>25</sup> The Examining Attorney has submitted articles and a Wikipedia entry explaining that different types of athletic shoes have different types of soles:

- “[T]he soles of athletic shoes offer sport-specific functions that can help improve your performance. Main technical and style features include differences in traction, flexibility, weight and even removable components.”<sup>26</sup>
- “Tennis shoes feature several different types of sole, depending on the type of surface on which you usually play.”<sup>27</sup>
- “Looking at the sole is a good place to start when you set out to find a new pair of athletic shoes, as it’s the foundation of the shoe.”<sup>28</sup>
- “The outer sole of the running shoe will be made of carbon rubber or blown rubber, which is made with injected air. A carbon rubber sole is made from a

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<sup>22</sup> *Id.* at 17.

<sup>23</sup> October 2, 2019 Request for Reconsideration at TSDR 6.

<sup>24</sup> August 23, 2018 Office Action at TSDR 2.

<sup>25</sup> *Id.* at 13 and 16.

<sup>26</sup> April 2, 2019 Final Office Action at TSDR 10.

<sup>27</sup> *Id.* at 16.

<sup>28</sup> *Id.* at 18.

heavier material, is somewhat stiffer, and provides more durability to the shoe.”<sup>29</sup>

- “Attributes of an athletic shoe include a flexible sole, appropriate tread for the function, and ability to absorb impact. As the industry and designs have expanded, the term ‘athletic shoes’ is based more on the design of the bottom of the shoe than the aesthetics of the top of the shoe.”<sup>30</sup>

This evidence establishes that soles are touted as an important feature of athletic shoes, which in turn, are a feature of Applicant’s services, namely, “online retail store services featuring running shoes, sports shoes.” The record also reflects a number of different manufacturers selling insoles for different types of athletic shoes.<sup>31</sup> Insoles fall within the broad category of “foot care products,” also identified as a feature of Applicant’s retail and online retail store services. Because the word “soles” describes an important characteristic of the goods featured in Applicant’s retail and online retail store services, it also is descriptive of Applicant’s services. *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 (TTAB 2003) (applicant’s mark, the Euro symbol (€), is merely descriptive for, inter alia, online financial services because the Euro is a feature of applicant’s services); *In re Pencils, Inc.*, 9 USPQ2d 1410, 1411(TTAB 1988) (finding the mark PENCILS merely descriptive of retail stationary and office supply stores because pencils are “significant stationery/office supply items”).

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<sup>29</sup> *Id.* at 33.

<sup>30</sup> *Id.* at 8.

<sup>31</sup> *Id.* at 58-64.

As combined in the applied-for mark, the terms “sporting” and “soles” retain their descriptive significance immediately describing a function or characteristic of Applicant’s services, namely, that Applicant’s retail and online retail store services feature sports shoes with soles designed for different sporting purposes and insoles designed for specific sporting purposes. They do not evoke a new and unique commercial impression and the combination results in a composite that is itself merely descriptive.

Applicant’s argument that its mark is a double entendre is unpersuasive. A double entendre is an “ambiguity of meaning arising from language that lends itself to more than one interpretation.” *In re The Place Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005) (quoting WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY (1993)). The multiple interpretations that make an expression a ‘double entendre’ must be associations that the public would make fairly readily, and must be readily apparent from the mark itself. *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1105 (TTAB 2018) (“A double entendre is registrable only if the second, non-descriptive meaning would be readily apparent to the consumer from the mark itself.”) *In re Calphalon Corp.*, 122 USPQ2d 1153, 1163 (TTAB 2017) (“The multiple interpretations that mark an expression a ‘double entendre’ must be associations the public would make fairly readily...”); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1213.05(c) (Oct. 2018).

A double entendre may arise where a combination of descriptive components creates a readily-understood alternative meaning. *In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008). Examples of double entendres include SUGAR & SPICE for

bakery products and MufFuns for baked mini muffins. *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382, 385 (CCPA 1968) (the mark SUGAR & SPICE for bakery products “clearly does not tell the potential purchaser *only* what the goods are, their function, their characteristics or their use, or, of prime concern here, their ingredients. The immediate impression evoked by the mark may well be to stimulate an association of ‘sugar and spice’ with ‘everything nice’” as in the nursery rhyme); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994) (because applicant’s inventive MufFuns mark for baked mini muffins is “an obvious play on the word ‘muffin’ and the word ‘fun,’ we believe that the meaning or commercial impression of applicant’s mark will be more than that simply of the word ‘muffins.’ Therefore, applicant’s mark is not merely descriptive.”).

In the above examples, the marks readily connote a known phrase or words. Here, the record does not support that “sporting souls” is a common or known phrase, and therefore, there is no basis for finding that consumers would readily substitute the homophone “souls” for “soles” and readily perceive Applicant’s mark as “sporting souls.” Nor is there a basis for finding that consumers would draw a connection between Applicant’s proposed mark and the unrelated phrase “old soul.” Accordingly, Applicant’s proposed mark does not qualify as a double entendre.

We also disagree with Applicant’s assertion that its mark is incongruous because “[t]he idea of ‘soles’ being ‘sporting’ is too strange to merely describe applicant’s services.” As discussed above, shoe soles and insoles are promoted as an important feature of sports shoes. Accordingly, consumers encountering Applicant’s mark are

likely to immediately understand that Applicant's retail and online retail store services feature athletic shoes with soles for sporting purposes and insoles designed for sporting purposes. That there is no evidence of "sporting soles" being used together or having an accepted meaning does not justify registration of this merely descriptive designation. *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

### **III. Conclusion**

Applicant's proposed mark is merely descriptive under Section 2(e)(1) of the Trademark Act because it immediately describes a feature or characteristic of Applicant's services.

**Decision:** The refusal to register Applicant's mark under Section 2(e)(1) of the Trademark Act is affirmed.